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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,921	02/20/2002	Robert G. Rinehart JR.	047850-0321	6485
25096	7590	09/21/2004		
PERKINS COIE LLP PATENT-SEA P.O. BOX 1247 SEATTLE, WA 98111-1247			EXAMINER LEE, EDMUND H	
			ART UNIT	PAPER NUMBER
			1732	

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/079,921	Applicant(s) RINEHART ET AL.	
	Examiner EDMUND H. LEE	Art Unit 1732	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 13-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>9/30/02</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 12 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/12/04.
2. Applicant's election without traverse of claims 1-11 and 13-20 in the reply filed on 8/12/04 is acknowledged.
3. Figure 5 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.121(d)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.
4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "the waterproof material" (cl 5) lacks antecedent basis in the claim.

Correction is required.
5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1,2,3 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Chen (USPN 5778473). Chen teaches the claimed process as evidenced by figs 1-9.

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-9 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (USPN 5778473). The above teachings of Chen are incorporated hereinafter. In regard to claim 4, the use of material that is substantially planar is a mere obvious matter of choice dependent on material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, substantially planar material is well-known in the molding and shoe art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use substantially planar material in the process of Chen in order to make storing of the material easier. In regard to claim 5, the use of a single piece of waterproof material is a mere obvious matter of choice dependent on material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, single pieces of waterproof material are well-known in the molding and shoe art. Thus, it would have

been obvious to one of ordinary skill in the art at the time the invention was made to use a single piece of waterproof material in the process of Chen in order to reduce molding complexity and ensure waterproofing of the lower. In regard to claims 6-8, the use of a specific material is a mere obvious matter of choice dependent on material availability and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, the claimed materials are well-known in the molding art for its strength and cost. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the claimed material in the process of Chen in order to produce a high-quality shoe. In regard to claim 9, it is well-known in the molding and shoe art to seal seams by stitching. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to seal the seams of Chen by stitching in order to reduce molding complexity without sacrificing quality. In regard to claim 11, Chen teaches disposing a liner adjacent to an inner surface of the lower or an inner surface of the upper through the top opening of the upper and attaching the liner to the inner surface of the lower or the inner surface of the upper. Chen, however, does not teach disposing the liner through the bottom opening of the lower. The disposition of the liner through the bottom opening of the lower is mere obvious matter of choice dependent on material type and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, disposing through the top of a preform is a well know substitutable alternative to disposing through the bottom of a preform. Thus, it would have been obvious to one of ordinary skill in the art at the

time the invention was made to dispose the liner of Chen through the bottom opening of the lower in order to reduce the risk of damaging the liner. In regard to claim 13, Chen teaches waterproof sealing by disposing a liner adjacent to an inner surface of the lower or an inner surface of the upper through the top opening of the upper and attaching the liner to the inner surface of the lower or the inner surface of the upper. Chen, however, does not teach accessing through the bottom opening of the lower. The disposition of the liner through the bottom opening of the lower is mere obvious matter of choice dependent on material type and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, disposing through the top of a preform is a well know substitutable alternative to disposing through the bottom of a preform. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to dispose the liner of Chen through the bottom opening of the lower in order to reduce the risk of damaging the liner.

9. Claims 14-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chen (USPN 5778473) in view of Norton et al (USPN 6670029). In regard to claim 14, Chen teaches the basic claimed process including a method of making a waterproof boot (figs 1-9); forming a lower from a rubber waterproof material, wherein the lower has an upper perimeter defining a top opening and a lower perimeter defining a bottom opening (figs 1-9); attaching the perimeter of the upper portion of the lower and a complementary lower portion of an upper to form a seam connection (figs 1-9); sealing the seam and the seam connection in a waterproof manner by accessing the seam and seam connection through the top opening of the upper (figs 1-9); and sealing the bottom

opening of the lower with a gasket in a water proof manner to form a footbed of a waterproof bed (figs 1-9). Chen, however, does not teach using a substantially planar, generally U-shaped piece of rubber; and accessing through the bottom opening of the lower. Norton et al teach molding a lower of a boot from a single piece of substantially planar, generally U-shaped piece of material. Chen and Norton et al are combinable because they are analogous with respect to forming a lower. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to form the lower of Chen from a single piece of substantially planar, generally U-shaped piece of material as taught by Norton et al in order to reduce molding complexity. In regard to accessing through the bottom opening of the lower, Chen teaches disposing a liner adjacent to an inner surface of the lower or an inner surface of the upper through the top opening of the upper and attaching the liner to the inner surface of the lower or the inner surface of the upper. Chen, however, does not teach disposing the liner through the bottom opening of the lower. The disposition of the liner through the bottom opening of the lower is mere obvious matter of choice dependent on material type and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, disposing through the top of a preform is a well know substitutable alternative to disposing through the bottom of a preform. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to dispose the liner of Chen through the bottom opening of the lower in order to reduce the risk of damaging the liner. In regard to claim 16, 17 and 19, such are taught by Chen (figs 1-9c). In regard to claims 15, the specific location of a

seam on the lower is a mere obvious matter of choice dependent on final design and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, heel seams are well-known in the molding and shoe art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to locate the seam of Chen (modified) at the heel in order to enhance aesthetic appeal of the boot. In regard to claim 18, the use of stitches to seal the seams is a mere obvious matter of choice dependent on final design and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, stitched seams are well-known in the molding and shoe art. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to stitch the seams of Chen in order to increase aesthetic appeal of the boot. In regard to claim 20, Chen teaches disposing a liner adjacent to an inner surface of the lower or an inner surface of the upper through the top opening of the upper and attaching the liner to the inner surface of the lower or the inner surface of the upper. Chen, however, does not teach disposing the liner through the bottom opening of the lower. The disposition of the liner through the bottom opening of the lower is mere obvious matter of choice dependent on material type and of little patentable consequence to the claimed process since it is not a manipulative feature or step of the claimed process. Further, disposing through the top of a preform is a well know substitutable alternative to disposing through the bottom of a preform. Thus, it would have been obvious to one of ordinary skill in the art at the time the



invention was made to dispose the liner of Chen through the bottom opening of the lower in order to reduce the risk of damaging the liner.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chen (USPN 6065227) teaches the state of the art.

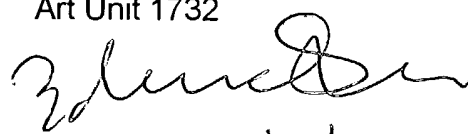
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDMUND H. LEE whose telephone number is 571.272.1204. The examiner can normally be reached on MONDAY-THURSDAY FROM 9AM-4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Colaianni can be reached on 571.272.1196. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EHL

EDMUND H. LEE  
Primary Examiner  
Art Unit 1732



9/20/04